

REMARKS

Claims 18, 20-23, 29, 31-34, 65, and 66 are pending in the application.

Applicants note that claims 23 and 33 are deemed withdrawn from consideration.

Applicants submit that both claims 23 and 33 read on the elected species and therefore are drawn to elected subject matter. Applicants respectfully request that claims 23 and 33 be rejoined and examined in concert with remaining pending claims 18, 20-23, 29, 31-34, 65, and 66 and allowed.

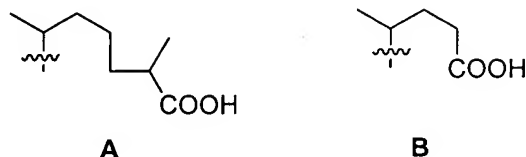
Applicants have reintroduced the phrase "carboxyl or" into the proviso at the end of claims 18 and 65. The aforementioned proviso now again reads "provided that when Z is substituted with carboxyl or alkyloxycarbonyl, either X or Z contains at least one double bond." This particular wording of this proviso was first introduced in Applicants' amendment filed on May 27, 2005. The moiety -X-Y-Z therefore cannot be fully saturated when Z is substituted with carboxyl or alkyloxycarbonyl. This is because claims 18 and 65 again require that when Z is substituted with carboxyl or alkyloxycarbonyl, then either X or Z must contain at least one double bond, thereby rendering -X-Y-Z unsaturated under these particular substitution conditions.

No new matter is introduced by these amendments.

Rejections under 35 U.S.C. § 102

Claims 18, 20-22, 29, 31, 32, 34, and 65 remain rejected under 35 U.S.C. § 102(b) as being anticipated by Kurosawa et al., *Steroids* **1997**, 62, 474-481 (Kurosawa). The Office relies upon the disclosure of compounds "1a-11a and 1d-11d" (Office Action, page 3) in Kurosawa as the basis for the rejection.

Compounds 1a-11a and 1d-11d in Kurosawa are steroid compounds in which the substituent corresponding to R¹⁷ in the formula delineated in claim 18 have formulae A and B, respectively:



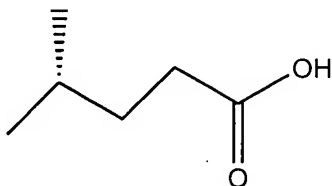
R¹⁷ in claims 18 and 65 is further defined as having the general formula “-X-Y-Z.” Accordingly, the substituent corresponding to R¹⁷ in Kurosawa's compounds 1a-11a and 1d-11d is one in which X is alkyl, Y is a bond, and Z is an alkyl moiety that is substituted with a carboxyl group (COOH). In other words, the substituent corresponding to Applicants' “-X-Y-Z” group (i.e., R¹⁷) in Kurosawa's compounds 1a-11a and 1d-11d is *in toto* a fully saturated carbon group in which the Z portion of this fully saturated carbon group is substituted with a carboxyl group.

In contrast, claims 18 and 65 as currently amended require that when Z is substituted with carboxyl (or alkyloxycarbonyl), then either X or Z must contain at least one double bond. In other words, Applicants' “-X-Y-Z” group cannot be a fully saturated carbon group when the Z portion of Applicants' “-X-Y-Z” group is substituted with carboxyl or alkyloxycarbonyl.

Applicants submit that Kurosawa does not anticipate independent claims 18 and 65 as currently amended because Kurosawa does not teach every element of claims 18 and 65 as currently amended. Since claims 20-22, 29, 31, and 32 depend from claim 18, they also are not anticipated by Kurosawa. In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection.

Claims 18, 20-22, 29, 31, 32, and 65 are rejected under 35 § U.S.C. 102(b) as being anticipated by Cohen-Solal et al., *Biochimica et biophysica Acta* **1995**, 1257, 189-197 (Cohen-Solal). The Office relies upon the disclosure of “hydoexychoic acid and α -hyochoic acid” (Office Action, page 3) in Cohen-Solal as the basis for the rejection.

Cohen-Solal discloses that plasma levels of cholesterol were lowered in animals treated with hydoxychoolic acid or α -hyocholic acid. Both hydoxychoolic acid and α -hyocholic acid are steroid compounds in which the substituent corresponding to R¹⁷ in the formula delineated in claim 18 has the following structure:



Accordingly, the substituent corresponding to R¹⁷ in hydoxychoolic acid and α -hyocholic acid is one in which X is alkyl, Y is a bond, and Z is an alkyl moiety that is substituted with a carboxyl group (COOH). In other words, the substituent corresponding to Applicants' "-X-Y-Z" group (i.e., R¹⁷) in hydoxychoolic acid and α -hyocholic acid of Cohen-Solal is *in toto* a fully saturated carbon group in which the Z portion of this fully saturated carbon group is substituted with a carboxyl group.

In contrast, claims 18 and 65 as currently amended require that when Z is substituted with carboxyl (or alkyloxycarbonyl), then either X or Z must contain at least one double bond. In other words, Applicants' "-X-Y-Z" group cannot be a fully saturated carbon group when the Z portion of Applicants' "-X-Y-Z" group is substituted with carboxyl or alkyloxycarbonyl.

Applicants submit that Cohen-Solal does not anticipate independent claims 18 and 65 as currently amended because Cohen-Solal does not teach every element of claims 18 and 65 as currently amended. Since claims 20-22, 29, 31, and 32 depend from claim 18, they also are not anticipated by Cohen-Solal. In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection.

Applicant : Shutsung Liao et al.
Serial No. : 10/705,398
Filed : November 10, 2003
Page : 10 of 10

Attorney's Docket No.: 10634-002002 / UCHI 751
Cont.

Applicants submit that all claims are in condition for allowance.

Enclosed is a \$225 check for the Two Month Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050, referencing Attorney Docket No.: 10634-002002.

Respectfully submitted,

Date: December 11, 2006

John T. Kendall
John T. Kendall, Ph.D.
Reg. No. 50,680

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

21506968.doc